

## REMARKS/ARGUMENTS

Claims 1-15 are pending in this application. Claims 1 and 7 are independent.

In the Office Action, the Examiner objects to the title of the invention as not being descriptive. Accordingly, Applicant has amended the title to recite “A Custom E-mail Filter to Prevent Unwanted Messages Using User-Defined Public/Individual E-mail Addresses.” In view of the above, Applicant respectfully requests withdrawal of the objection to the title of the invention.

### Rejection Under 35 U.S.C. § 112

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that as to claims 1, 7, 13, and 14, “it is not clearly defined in the specification what the term ‘public e-mail address’ embodies.” As to claim 6, the Office Action states “it is not exactly clear after reading the specification as to what the rewriter unit function does.”

The Office Action states on pages 2-3 that “the Examiner will interpret the term [public e-mail address] to be any addresses associated to e-mail including individual e-mail, alias e-mail, group or distribution list e-mail and many others.” This, however, is not a proper interpretation of the term “public e-mail address” as used throughout the specification. A public e-mail address is an **e-mail address that is associated with a user together with a private e-mail address** that are owned by a user and managed by an e-mail server device. The public e-mail address is an e-mail address that is published, for example, on a web site, business card, etc. A private e-mail address, however, is an e-mail address that is only disclosed to particular third-parties or not at all. Converting the public e-mail address generates the private e-mail address. For example, a

public e-mail address of john.smith@generic.com may be converted to a private e-mail address of 1234.john.smith@generic.com. See, for example, page 13, line 27 - page 14, line 8 of the specification.

Upon receipt of an e-mail transmitted to a public e-mail address of an addressee, the e-mail server device refers to a sender's e-mail address. The e-mail server device determines whether to forward the e-mail to the private e-mail address of the addressee. This determination is made by comparing the sender's e-mail address or user identification with a list of pre-approved senders. If the sender's e-mail address is provided in the list of pre-approved senders, the e-mail server device forwards the e-mail to the private e-mail address of the addressee. If the sender's e-mail address is not on the pre-approved list, the e-mail server device may notify the sender that no such e-mail address exists or that another action may be required. Alternatively, the e-mail server device may query the addressee regarding whether to accept the e-mail to be delivered. Therefore, a public e-mail address as used throughout the specification is not "any address associated to e-mail", however, but an e-mail address that is also associated with a private e-mail address, both of which are owned by a single user.

Regarding claim 6, Applicant has amended claim 6 to further clarify Applicant's invention. Claim 6 has been amended to recite that the public e-mail address is "owned by" the addresser and that "the addresser of the received e-mail is the public e-mail address owned by the user specified in the user information managed by said e-mail server device." The rewriting unit recited in claim 6 is used to convert a public e-mail address of a sender to a private e-mail address of the sender. This may be performed when a recipient of an e-mail from the sender is indicated as a trusted recipient. For example, the sender may compose an e-mail to the recipient. By default, the sender's public e-mail address, for example, john.smith@generic.com, may be

inserted into a “From” field in the e-mail. The sender, however, may indicate that the recipient is a trusted recipient and permit the sender’s private e-mail address to be transmitted to the recipient. Therefore, the rewriting unit of the e-mail server device converts the sender’s public e-mail address (*i.e.*, john.smith@generic.com) to the sender’s private e-mail address (*i.e.*, 1234.john.smith@generic.com). The recipient then receives the e-mail having the sender’s private e-mail address. The recipient may then use the sender’s private e-mail address, instead of the sender’s public e-mail address, when sending e-mail to the sender. This enables the e-mail server device to bypass determining whether to forward the e-mail to the sender and merely forward the e-mail to the sender. See, for example, page 17, lines 16-23.

#### **Rejection Under 35 U.S.C. § 103(a)**

Claims 1-3, 7-9, and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,691,156 to Drummond *et al.* (“Drummond”) in view of U.S. Patent No. 6,480,885 to Olivier (“Olivier”). Claims 4-5 and 10-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond in view of Oliver and U.S. Patent No. 5,752,059 to Holleran *et al.* (“Holleran”). Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond in view of Olivier and U.S. Patent No. 5,822,526 to Waskiewicz (“Waskiewicz”). Applicant has amended independent claims 1 and 7 to include claim language that recites “the user information specifying an e-mail address as a public e-mail address owned by the at least one user and another e-mail address as an individual e-mail address owned by the at least one user.” Drummond does not disclose such a system.

As discussed above, both a public e-mail address and a private (*i.e.*, individual) e-mail address are associated with a user. The public e-mail address may be published using a plurality of mediums, for example, web sites, business cards, letterheads, word of mouth, etc. The

individual e-mail address, however, may only be provided to certain individuals. Although two (2) e-mail addresses are provided, each address is associated with a single user. As recited in claims 1 and 7, the user information specifies “a public e-mail address owned by the at least one user and... an individual e-mail address owned by the at least one user.” The user may use the public e-mail address as an intermediary to reduce an amount of unwanted e-mails. For example, the user may publish the public e-mail address by registering with various web sites. Registering with certain web sites, however, exposes the public e-mail address to being placed on mailing (*e.g.*, spamming) lists that results in potentially unwanted mail from being received. To reduce an amount of unwanted e-mail, the user may identify approved senders from whom the user desires to receive e-mail. Upon receiving e-mail from an approved sender, the public e-mail address provided in the e-mail is converted to the user’s individual e-mail address and the e-mail is forwarded to the user. If the sender is not approved, the invention transmits a message notifying the sender that, for example, no such user exists, another action may be required, the e-mail address is no longer valid, etc. The user does not receive e-mail from senders who are not approved. This reduces an amount of spam that the user receives.

Drummond does not disclose a user having both a public e-mail address and an individual e-mail address associated with the user as claimed. Drummond discloses an e-mail system that transmits a request from an e-mail server to a sender of an e-mail for a return acknowledgement. The system does not forward the e-mail to the user unless the return acknowledgement is received within a given time period. If the return acknowledgement is received within the time period, the e-mail is deemed authentic and forwarded to the user. If the return acknowledgement is not received within the time period, the e-mail is not forwarded to the user. This assists in reducing spam e-mail “because spamming is typically accomplished by automated routines that

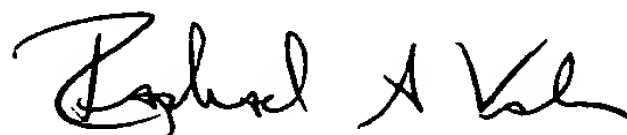
cannot or do not respond to the e-mail's server's request for acknowledgement." Column 2, lines 53-56. Nowhere does Drummond disclose user information specifying a public e-mail address and an individual address as claimed. Drummond only discloses one e-mail address per user and reducing spam by requiring a return acknowledgement prior to forwarding an e-mail to the user from an unapproved sender.

In view of the above, Applicant respectfully submits that Claims 1-15 are in condition for allowance.

### **Conclusion**

Based on the foregoing, favorable reconsideration and allowance of the claims is solicited. If necessary, the Commissioner is hereby authorized in this and concurrent replies to charge payment (or credit any overpayment) to Deposit Account No. 50-2298 for any additional fees required under 37 CFR 1.16 or 1.17.

Respectfully submitted,



---

Raphael A. Valencia  
Attorney for Applicant(s)  
Reg. No. 43,216

c/o Luce, Forward, Hamilton & Scripps LLP  
11988 El Camino Real, Suite 200  
San Diego, California 92130  
(858) 720-6300